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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,344	02/19/2002	Pieter Lykle Buwalda	294-108 PCT/US	4155

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08/22/2003

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EXAMINER

BHAT, NINA NMN

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,344

Applicant(s)

BUWALDA ET AL.

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>Z</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. The disclosure is objected to because of the following informalities: Applicant is requested to provide the heading "Brief Description of the Drawings" and the description of each drawings prior to discussing the drawings in the specification. The examiner notes that a listing of the brief description of the drawings have been found at the end of the specification before the claims. These should be moved up into the specification as described above. Appropriate correction is required.
2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Applicant recites in the preamble a method for providing an improved foodstuff with a short or smooth texture and/or shiny appearance after heat and/or shear treatment comprising adding to a foodstuff a cross-linked starch. The method is incomplete because it unclear whether the foodstuff has been subjected to heat or shear or the texture is changed. The only step is adding a cross-linked starch to the foodstuff. It is unclear how that would improve the foodstuff. The only step is adding a cross-linked starch to the food, the proviso of the starch being able to disintegrate into discrete particles after processing does not further limit the process and the process doesn't even contain steps that the foodstuff is processed. Suitable correction is required as the claims are incomplete and lack clarity.
3. Claims 2-9 are rejected as being dependent upon a rejected base claim.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeffcoat et al. EP 0 796 868.

Jeffcoat et al. teach providing a foodstuff, which were thickened by the inclusion of an effective amount of a cross-linked waxy potato starch, specifically a hydroxypropylated waxy potato distarch phosphate. The foodstuff prepared using the cross-linked waxy potato starch is improved in flavor, texture and appearance. [Note the abstract] The waxy potato starch is stabilized exhibiting high viscosity, good clarity and short smooth texture. [Note Page 2 line 59 and Page 3, line 1]. The foodstuff can include an edible product and includes products such as pourable or spoonable dressings, pie fillings, fruit and cream fillings, white sauces dairy based sauce such as cheeses, gravies, light syrups, puddings, custards, yogurt, sour cream, beverages, glazes, and soups. [Note Page 3, lines 50-55] Jeffcoat et al. teach that the waxy potato starch is a high amylopectin containing starch, which discourages reassociation so that gelling, does not readily occur and the resulting pastes are more flowable and clear. Jeffcoat et al. further teach that the prior art patents product starch high in either amylose or amylopectin which include physical means of separation, classical plant breeding and genetically engineered modifications that are engineered to suppress the formation of amylose producing a potato with a starch content containing essentially pure amylopectin. [Note Pate 1, lines 20-24] One of ordinary skill in the art, from

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reading Jeffcoat et al. EP 0 796 868 and WO 92/11376 and CA 2,016,443 incorporated in the Jeffcoat et al. European patent would realize that the waxy potato starch would inherently have a amylopectin to amylose ratios within in the range as claimed by applicant. Jeffcoat et al. teach that the stabilized cross-linked waxy potato starch exhibits excellent stability when subjected to various processing and storage conditions which include high temperature, low temperature and high shear conditions and are useful in foods which are retorted, aseptically packaged or frozen or combinations thereof.[Note Page 4, lines 18-25]. The Jeffcoat et al. European Patent teaches applicant's method and food article containing a cross-linked starch as claimed thus anticipating applicant's invention.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9 and 11-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/236,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because in both applications

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the claims are directed to a method of adding to a foodstuff a cross-linked waxy starch such as a waxy potato starch or a non-cereal starch, in the instant application the claims are broader than that claimed in the 10/236,435 application which is directed to a bakery filling which includes the cross-linked waxy non-cereal starch which can be a waxy potato starch, the instant application is broader in scope and does not preclude the addition of the waxy non-cereal starch to a bakery filling, the recitation encompasses any edible food and thus to use the cross-linked starch in a bakery filling would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jeffcoat et al. '890 and '060 are basically US equivalents of the Jeffcoat et al. European '868 patent used in the rejection. PGPUB 2003/0087006 teaches a heat stable high amylopectin starch used in bakery fillings. Jeffcoat et al. '822 teach thermally inhibited pregelatinized non-granular starches and flours. Senkeleski et al. teach a thermally inhibited enzymatically hydrolyzed ungelatinized granular starch. Xu et al. teach a viscosifier prepared by enzymatically hydrolyzing an ungelatinized granular starch comprising waxy maize and tapioca starch.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat
Primary Examiner
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